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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,769	12/21/2001	Sandrine Decoster	05725.0993	2464
22852	7590	04/21/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/018,769	DECOSTER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gina C. Yu	1617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 18,20-28 and 30-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18, 20-28, 30-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Receipt is acknowledged of Amendment filed on February 4, 2004. The finality of the Office action dated November 4, 2003 is withdrawn in view of applicants' remarks. Claim rejections made under 35 U.S.C. § 102 as indicated in the same Office action are withdrawn in view of applicants' remarks. Claim rejections made under 35 U.S.C. § 103 as indicated in the same Office action are withdrawn and modified to meet the amended claims. Claims 18, 20-28, 30-51 are pending.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 18, 20-28, and 30-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 99/13830) ("Mitsumatsu") in view of Sebag et al. (WO 98/03155) ("Sebag").

Mitsumatsu teaches shampoo formulations comprising trizole, an optical brightener, and either stearyl alcohol or behenyl alcohol. See Examples 3-5. Detergent surfactants such as ammonium lauryl sulfate and cocamidopropylbetaine are used within the claimed amount. See instant claims 37-39. Conditioning agents such as silicone emulsion are used. See instant claims 40-44. See p. 45, lines 9 – 14 for the method of use. See instant claims 49-51.

While the example formulations do not concurrently use stearyl alcohol and behenyl alcohol within a same composition as recited in the instant claims, the

Mitsumatsu patent suggests using cetyl alcohol, stearyl, behenyl alcohol, and mixtures thereof. See p. 24, lines 16 – 20. These compounds, collectively named as “high melting point compounds” in the reference, are said to cover the hair surface and reduce friction, providing smooth feel and easy combing. See p. 23, line 31 – p. 24, line 15. The Example formulation 4 and 5 shows concurrent use of cetyl alcohol and stearyl alcohol in the ratio of 1:1 and 1:2, which renders the use of stearyl alcohol and behenyl alcohol within the claimed range obvious. See instant claims 32 – 34.

For instant claims 26-31, while the Mitsumatsu Examples do not show the recited weight range of the fatty alcohols, examiner notes that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. Since the general conditions of the instant claims are disclosed in Mitsumatsu, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. Raising the concentration of an active component to enhance the effect of the “high melting point compounds” would have been obvious to the routineer.

Mitsumatsu, discussed above, fails to teach the opacifier/pearlescent recited in claims 19-25.

Sebag teaches hair washing and conditioning compositions comprising a dialkyl ether of formula (II) in instant claim 22, and preferably distearyl ether. See English equivalent of Sebag, US 6162423, col. 2, lines 26 – 53; col. 1, lines 4- 66. The reference teaches that the use of at least one fatty dialkyl ether used in the instant

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invention renders a washing foaming compositions having insoluble silicones and surfactants, pearlescent effect, good homogeneity, and improved stability while maintaining foaming power. See Example 1, which comprises 4 % by weight of stearyl ether and 1 % by weight of cetylstearyl alcohol.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shampoo compositions comprising silicone emulsion in Mitsumatsu by substituting the triazole with distearyl ether as motivated by Sebag, because of the expectation of successfully producing shampoo compositions with similar pearlescent effect, good homogeneity with improved stability and foaming power.

#### ***Response to Arguments***

Applicant's arguments filed February 4, 2004 have been fully considered and are unpersuasive in part.

Examiner maintains the position that applicants provided no evidence that the substitution of the Mitsumatsu optical brightener with the Sebag pearlescent agents is somehow insufficient. Regarding applicants' argument that examiner "has not presented objective evidence to support the subjective unsupported assertion of obviousness", examiner respectfully points out that the motivation to use the Sebag pearlescent agent in the hair shampoo formulation is objectively and notoriously found in the reference where it indicates and that the composition the use of at least one fatty dialkyl ether used in the instant invention renders a washing foaming compositions having insoluble silicones and surfactants, pearlescent effect, good homogeneity, and

improved stability while maintaining foaming power. Examiner earlier remarks regarding the absence of evidentiary support for the applicants' arguments refers to the fact there is no convincing arguments or evidence to rebut the objective teachings that a hair cleansing composition comprising the Sebag pearlescent agent would impart such cosmetic benefits.

While applicants' argue that there is no expectation of success in substituting the Sebag pearlescent agent for the Mitsumatsu optical brightener, examiner respectfully notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, examiner thus takes the position that the obviousness standard does not require the Office to show that the exact formulation of the Sebag pearlescent agent incorporated in Mitsumatsu composition in place of the optical brightener. Both Mitsumatsu and Sebag inventions are directed to hair washing compositions which impart aesthetic, shining effects on hair. Applicants argue that optical brighteners change hair color and enhance the shine of hair, whereas opacifier and pearlescent agents give opacity and pearlescence to the composition. In response, examiner notes that it is clearly taught in Sebag that the invention imparts shiny hair as well. It is viewed that the objective teachings of the references clearly provides motivation to substitute one over the other.

***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

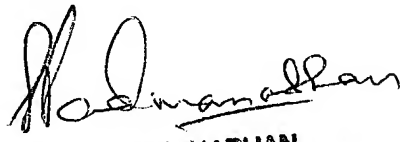
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner



**SREENI PADMANABHAN**  
SUPERVISORY PATENT EXAMINER